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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,104	11/12/2003	Douglas Craig Scott	9118M	5134

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THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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03/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,104	Applicant(s) SCOTT ET AL.	
	Examiner SHIRLEY V. GEMBEH	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20,24-29,31,32,34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20,24-29,31,32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/9/08 has been entered.
2. Applicant's arguments filed 12/9/08 have been fully considered but they are not deemed to be persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 18-20, 24-29, 31-32, 34 and 36 are pending in this office action. Claim 36 is newly added. Claims 1-17, 22-23, 30, 33 and 35 are cancelled.
5. The rejection of claims 21, 32 and 34 under 35 U.S.C 103(a) as being unpatentable over Lawlor (US 6,706,256 B2) in view of La Rochelle (US 4,157,386) and Aberg et al. (WO 88/10110) as set forth in the last Office action is withdrawn because of the amendment of the claims to a combination of 7% hydroxyethyl cellulose and about

4% carboxymethyl cellulose, and because the Scott Declaration submitted under 37 CFR 1.132 filed 12/9/08 is sufficient to overcome this rejection of these claims as illustrated in the side by side comparison argued by Declarant. Applicant should note that the rejection may be reinstated if the claims are amended to overcome the New Matter Rejection below.

However, these claims are rejected under the written description as New Matter. See below.

6. Applicant's arguments with respect to claims 18-20, 24-29, 31-32, 34 have been considered but are moot in view of the new ground(s) of rejection.

Declaration

7. The declaration of Douglas Craig Scott submitted under 37 CFR 1.132 filed 12/9/08 is insufficient to overcome the rejection of claims 18-20, 24-29 and 31 based upon the rejection Lawlor (US 6,706,256 B2) in view of La Rochelle (US 4,157,386) and Aberg et al., (WO 88/10110) as set forth in the last Office action because:

The declaration is not commensurate in scope with the claimed invention. The claims are broader than what is shown as an unexpected result. For example the claims recite "... composition comprising from about 7% to about 25% by weight of the composition of a retentive agent comprising hydroxyethylcellulose and carboxymethylcellulose..." while the declaration presents data with only 7%

hydroxyethyl cellulose and about 4% carboxymethyl cellulose (i.e., only one point data). Therefore, the showing of only one point data is not commensurate in scope because Declarant has not reasonably show results over the wide range claimed. Thus the declaration is not persuasive.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21, 32, 34 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter Rejection.

The claims recite the newly amended limitation of "...7% hydroxyethyl cellulose and about 4% carboxymethylcellulose"; however, the specification as-filed does not provide a conception of possession of the metes and bounds of this phrase. The instant claims now recite limitations which were not clearly disclosed in the specification as-filed and therefore now broaden the scope of the instant specification.

Page 8 of Applicant's remarks states support of the amendment can be found on page 7 and 8 of the specification. Contrary to Applicant's assertion, pages 7-8 only disclose the embodiment of 1%-40%, 7%-25%, 8%-20% and 11%-18% of the retentive

agent, and fail to show any combination of the individual agents in the concentrations recited in instant claims 21, 32 and 34.

Applicant is invited to identify sufficient written support in the original specification for the "limitations" indicated above.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18-20, 24-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor (US 6,706,256).

Lawlor teaches an oral care formulation (dentifrice) comprising 0.1%- 15% of hydroxyethyl cellulose and carboxymethyl cellulose (as required by instant claim 18(a); see col. 21, lines 45-56) and a flavoring agents, and abrasives (as required by instant claim 18(b); see col. 18, lines 1-10). Inherently when chewed the oral formulation (chewing gum, breath mints, see col. 7, lines 1-50) is expected to form an hydrated mass that will be visible on 2-3 molars or greater for at least 5 mins (as it also relates to claims 18 and 19; see also col. 17, lines 19-32,) because Lawlor also teaches embodiments such as non-cariogenic compositions (see col. 20, lines 43-55) having the

same structurally components claimed, which thus will function the same and remain on the tooth for more than 5 mins; absent evidence to the contrary. Lawlor also teaches that the composition is combined with brushing (see col. 24, lines 45-48), and thus expectorating the slurry is further reasonably anticipated. With regards to instant claim 20, Lawlor teaches the composition has a crunch texture when chewed, and therefore would also be expected to at least deposit 0.5% of the crunchy composition on the tooth; absent evidence to the contrary.

Lawlor also teaches the composition comprises additional agents such as H-2 antagonists, anticalculus, fluoride ions (as required by instant claims 24 and 25; see col. 9, lines 59-67) in a compressed tablet (as required by instant claim 26; see col. 15, lines 46-48). With the limitation wherein the composition is non-effervescent, it is anticipated that chewing gum and hard candies are non-effervescent, thus the limitation of instant claim 27 and 31 is met. Lawlor further teaches the oral composition comprises a buffering agent wherein the buffering agents have a pH of 3-10. Therefore when chewed the composition will buffer the oral cavity within the recited claimed limitations (as required by instant claims 28-29, see col. 22, lines 1-16).

Lawlor further teaches the oral composition comprises metal cation salts which are water insoluble salts less than 2% of insoluble particulates (i.e., less than 65%; see col. 12, lines 56-60 and col. 14, lines 36-40 as required by instant claim 28).

Applicant should note that "products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

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properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." See MPEP 2112.01

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL HARTLEY can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/S. V. G./
Examiner, Art Unit 1618
3/10/09

/Robert C. Hayes/
Primary Examiner, Art Unit 1649